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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,734	08/18/2003	Philippe Richard	SFPA0004	4101
75671                      7590                      11/16/2009 Sadler, Breen, Morasch & Colby, ps 422 W. Riverside Ave, Suite 424 Spokane, WA 99201				
EXAMINER				
KIM, JUNG W				
ART UNIT		PAPER NUMBER		
2432				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/643,734

**Applicant(s)**

RICHARD, PHILIPPE

**Examiner**

JUNG KIM

**Art Unit**

2432

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8-10, 12, 13, 33-38, 41, 42, 44-48, 51-53, 55 and 56 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5, 8-10, 12, 13, 33-38, 41, 42, 44-48, 51-53, 55 and 56 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on 10/13/09.
2. Claims 1-5, 8-10, 12, 13, 33-38, 41, 42, 44-48, 51-53, 55 and 56 are pending.

### ***Response to Amendment***

3. The after-final amendment has not been entered to rectify the prior art rejection that was based on an incorrect priority date. As noted by the applicant on pg. 11, of the Remarks filed on 10/13/09, the subject matter of most of the claimed invention is supported by the parent patent US 7,124,435 (the instant application is a continuation in part of the parent patent), which predates the Fernando prior art. Hence, the rejections of these claims have been withdrawn and the finality of the rejection is withdrawn. However, the claimed invention as filed on 4/23/09 has not been found to be novel in view of prior art Gray et al. US 6,094,676 and Aravamudan et al. US 6,301,609. It is noted that these rejections are directed to the disposition of the claims as filed on 11/24/09. Hence, these rejections are made final in view of the amendments to those claims. Although the amendment filed on 10/13/09 has not been entered, it is noted that the indicated changes to claims 33-38, 41 and 42 would be sufficient to overcome the 101 rejection.

### ***Terminal Disclaimer***

4. Applicant filed a terminal disclaimer on 10/13/09 disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of prior patent No. 7,124,435 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The Disclaimer is currently being reviewed by the office.

#### ***Response to Arguments***

5. Applicant's arguments that claims 1-4, 8-10, 12, 13, 33-36, 41, 42, 44-47, 51-53, 55 and 56 are supported by the Parent patent 7,124,435 are persuasive. Hence, the rejections of these claims as being anticipated by Fernando are withdrawn. However, claims 1, 2, 4, 8, 10, 13, 33, 34, 36, 38, 42, 44, 45, 47, 51, 53 and 56 are newly rejected as being anticipated by Gray et al. US 6,094,676 and Aravamudan et al. US 6,301,609.

6. It is further noted that applicant does not provide any support in the parent application for claim 38, and no support in the parent application for the limitations defined in claim 38 was found. Hence, claim 38 remains rejected as being anticipated by Fernando.

#### ***Claim Rejections - 35 USC § 101***

7. Claims 33-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 33-43 are directed to an article of manufacture including but not limited to a signal bearing medium. This new preamble is

deficient for the following reasons: although the preamble defines "an article of manufacture including but not limited to a signal bearing medium," the limitation "an article of manufacture" is merely a signifier for a category of invention that does not identify the scope of an article of manufacture, i.e. a claim for an "article of manufacture" can be any and all creations by man. As such, the limitation "an article of manufacture" by itself is meaningless in determining whether the claimed invention is statutory. For example, a claim defined as "an article of manufacture comprising a signal" is clearly not one of the four statutory categories of patent eligible subject matter. See *In re Nuijten*. To determine the meets and bounds of the claimed invention, the limitation "an article of manufacture" must be interpreted with respect to the limitations defined in the remainder of the claim. In this case, nothing in the claim suggests any boundaries for the article of manufacture except that it stores instructions and is capable of being executed by a discovery machine. However, one of ordinary skill in the art would recognize that a signal stores instructions and is capable of being executed by a discovery machine. Hence, claims 33-43 remain rejected under 101.

***Claims Rejections – 35 USC § 102***

8. Claim 38 is rejected under 35 U.S.C. 102(e) as anticipated by Fernando et al. 7,124,435 (hereinafter Fernando)

9. As per claim 38, Fernando discloses an article of manufacture but not limited to a signal bearing medium having instructions stored thereon that, if executed by a discovery machine, cause the discovery machine to perform a method comprising:

- a. determining whether a first user associated with a first client machine will accept a communication from said second user associated with a second client machine, the first and second users being registered with said discovery machine (col. 6:5-13, first user sends the encrypted session key and the first user public key to the central server when the first user accepts the request from the second user);
- b. if said first user will accept said communication, establishing a direct link between said first client machine and said second client machine to deliver said communication wherein if established said direct link is configured such that said communication is not delivered through said discovery machine and wherein no direct link is established if said first user will not accept said communication;
- c. Wherein at least one of said first user and second user maintains a plurality of contact information (4:20-23, instant messaging applications provide updateable contact lists).

10. Claims 1, 2, 4, 8, 10, 13, 33, 34, 36, 38, 42, 44, 45, 47, 51, 53 and 56, are rejected under 35 U.S.C. 102(b) as anticipated by Gray et al. US 6,094,676 (hereinafter Gray)

11. As per claims 1, 2, 4, 8, 10 and 13, Gray discloses a method comprising:
- d. determining by said discovery machine whether a first user associated with a first client machine will accept a communication from said second user (col. 5:11-15, the receiving unit publishes its network address using an address locator service if the receiving unit wishes to receive the communication from the sender);
  - e. if said first user will accept said communication, establishing a direct link between said first client machine and said second client machine to deliver said communication wherein if established said direct link is configured such that said communication is not delivered through said discovery machine and wherein no direct link is established if said first user will not accept said communication (5:31-40; sending unit transmits messages using the published IP address only if IP address is published by receiver; furthermore, locator service does not participate in the exchange of messages);
  - f. Wherein said direct link is closed after said communication is delivered (5:40-43; channel is disconnected at the end of the session);
  - g. Wherein a new direct link is established between said second client machine and said first client machine to communicate a new communication (each time the first and second clients wishes to communicate, the process is repeated);
  - h. Wherein a third user can initiate a new communication to at least one of said first and said second user via a web page interface coupled to said

discovery machine (5:11-42; sender and receiver in the prior art refers to any two clients within the network);

i. Wherein at least one of said first user and second user can selectively block said new communication (4:35-5:10, receiving unit has the option of publishing it's IP address);

j. Wherein said discovery machine is a central server (fig. 4, reference 40).

12. As per claims 33, 34, 36 and 42, they are claims corresponding to claims 1, 2, 4, 8, 10 and 13, and they do not teach or define above the information claimed in claims 1, 2, 4, 8, 10 and 13. Therefore, claims 33, 34, 36 and 42 are rejected as being anticipated by Gray for the same reasons set forth in the rejections of claims 1, 2, 4, 8, 10 and 13.

13. As per claim 38, the rejection of claim 33 under 35 USC 102(b) as being anticipated by Gray is incorporated herein. In addition, Gray discloses wherein at least one of said first client machine and said second client machine maintains a plurality of contact information. (col. 5:258-30; each sending device has a list of identifying information to communicate with at least one receiving device)

14. As per claims 44, 45, 47, 51, 53 and 56, they are claims corresponding to claims 1, 2, 4, 8, 10 and 13, and they do not teach or define above the information claimed in claims 1, 2, 4, 8, 10 and 13. Therefore, claims 44, 45, 47, 51, 53 and 56 are rejected as



being anticipated by Gray for the same reasons set forth in the rejections of claims 1, 2, 4, 8, 10 and 13.

15. Claims 1, 2, 4, 8, 10, 13, 33, 34, 36, 38, 42, 44, 45, 47, 51, 53 and 56, are rejected under 35 U.S.C. 102(e) as anticipated by Aravamudan et al. US 6,301,609 (hereinafter Aravamudan).

16. As per claims 1-5, 8-10, 12 and 13, Aravamudan discloses a method comprising:
- k. determining by said discovery machine whether a first user associated with a first client machine will accept a communication initiated by a second user associated with a second client machine, wherein said first and second users are registered with said discovery machine (col. 5:52-6:31, the CSP includes a services executive which maintains registered client communications information; 7:5-8, user's CPE generates a message indicating online status; user can also decide whether to allow or deny messages, see 7:21-40 and 11:35-45; see also figs. 1 and 2);
  - l. if said first user will accept said communication, establishing a direct link between said first client machine and said second client machine to deliver said communication wherein if established said direct link is configured such that said communication is not delivered through said discovery machine and wherein no direct link is established if said first user will not accept said communication (10:53-11:7; when a user has identified a buddy with the highest priority, user's

proxy is identified as being off-line and messages from the buddy can be transmitted directly to the user; the user can decide which user has the highest priority; in addition, the user can decide which messages to allow. See 11:35-45);

m. Wherein said direct link is closed after said communication is delivered (by virtue of the fact that the communication session terminates);

n. Wherein if said first user is not available to receive said communication, said communication is stored by said discovery machine until said first user becomes available (7:20-33, pending events, including received messages are stored by the CSP; 11:35-45);

o. Wherein a new direct link is established between said second client machine and said first client machine to communicate a new communication (each time the first and second clients wishes to communicate, the process is repeated);

p. Wherein a thread of related previous communications is prefixed to said new communication (IM services and e-mail services store and display prior communications)

q. Wherein a third user can initiate a new communication to at least one of said first and said second user via a web page interface coupled to said discovery machine (IM and e-mail messages are sent via a networked GUI);

- r.     Wherein a third user can initiate a new communication to at least one of said first and second user through a simple mail transfer protocol via said discovery machine (7:27, messages sent via e-mail);
  - s.     Wherein at least one of said first user and second user can selectively block said new communication (11:40-45, user can selectively block a new communication);
  - t.     Wherein determining that said first user will accept said communication includes storing notification of said communication if said first user is unavailable (7:20-25, pending events, including messages received while the user was offline );
  - u.     Wherein said discovery machine is a central server (figs. 1 and 2, reference no. 160, CSP).
17.    As per claims 33-37, 41 and 42, they are claims corresponding to claims 1-5, 8-10, 12 and 13, and they do not teach or define above the information claimed in claims 1-5, 8-10, 12 and 13. Therefore, claims 33-37, 41 and 42 are rejected as being anticipated by Aravamudan for the same reasons set forth in the rejections of claims 1-5, 8-10, 12 and 13.
18.    As per claim 38, the rejection of claim 33 under 35 USC 102(e) as being anticipated by Aravamudan is incorporated herein. In addition, Aravamudan discloses wherein at least one of said first client machine and said second client machine

maintains a plurality of contact information. (each CPE device has a list of identifying information to communicate with at least one buddy)

19. As per claims 44-48, 51-53, 55 and 56, they are claims corresponding to claims 1-5, 8-10, 12 and 13, and they do not teach or define above the information claimed in claims 1-5, 8-10, 12 and 13. Therefore, claims 44-48, 51-53, 55 and 56 are rejected as being anticipated by Aravamudan for the same reasons set forth in the rejections of claims 1-5, 8-10, 12 and 13.

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Communications Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jung Kim/  
Primary Examiner, AU 2432